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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY G. LUTFALLAH

Appeal 2008-3524
Application 10/752,406
Technology Center 3600

Decided: August 8, 2008

Before DEMETRA J. MILLS, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 24, 30-33, 35, and 36. We have jurisdiction under 35 U.S.C. § 6(b). Claims 24 and 35 are representative of the claims on appeal, and read as follows:

24. A window stop for use in a window assembly having an upper sash and a lower sash, each sash slidably mounted in a master frame, each sash having a top rail a bottom rail and a pair of vertical stiles, each vertical stile having a front wall, the window stop comprising:

- a housing defining a cavity, the housing having a cover defining a lip, the housing further having a tab having an inclined engagement surface in spaced relation to the lip, the engagement surface comprising a plurality of ridges, at least one of which is inclined away from the lip, wherein the engagement surface and lip are adapted to be adapted to cooperatively engage the frame member, the frame member being any of a plurality of frame members having a thickness between a minimum thickness and a maximum thickness, the housing further having a projection extending into the cavity;

- a bolt operably mounted within the cavity and moveable between a retracted position wherein the bolt is located substantially within the housing and thereby out of the path of movement of the lower sash and an extended position wherein the bolt extends from within the cavity and into the path of movement of the lower sash;

- means for biasing the bolt towards the extended position, and

- an actuator pivotally mounted to the bolt having a hook at one end for engaging the projection to retain the bolt in the retracted position when the actuator is in a locked position, the actuator pivotable from the locked position to a release position wherein the hook disengages from the projection to permit the bolt to move towards the extended position.

35. A window stop comprising:

- a housing defining a cavity, the housing having an end wall and a cover defining a lip;

- a tab having a base portion mounted to the end wall and extending away from the end wall, the tab having a planar engagement surface distal from the base portion, the planar engagement surface being spaced from the lip and inclined with respect to the lip, the planar engagement surface extending from an inner edge of the tab proximal to the housing to an outer edge of the tab distal from the housing; and

- a bolt mounted within the cavity and moveable between a retracted position wherein the bolt is substantially located within the housing and a locking position wherein the bolt extends from the cavity.

The Examiners relies on the following references:

Bratcher	US 5,806,900	Sep. 15, 1998
Kojima	US 6,575,681 B2	Jun. 10, 2003

We affirm.

BACKGROUND

According to the Specification, in sliding window assemblies, “it is important to be able to selectively limit the distance the sliding window sash may travel,” such as to allow for venting while preventing ingress or egress through the window (Spec. 1). The Specification teaches further that

window stops of all types include some means for mounting the stop usually within a vertical stile of the upper sash window. As noted above, sash windows are now being formed of extruded plastic or metal frame members which are joined at mitered corners, to form a generally rectangular frame. This results in an essentially hollow sash window frame. Window stops are typically mounted such that a housing of the stop is substantially positioned within a frame member of the hollow sash, with a cover of the housing resting on an outer surface of a wall of the frame member. To secure the stop within the sash, a wall of the frame member is received between the cover and a tab extending from the housing. In the past, the cover and the tab(s) for any given window stop have been capable of being mounted in a frame member having a wall of only a single thickness. This causes window stop manufacturers to produce multiple housings based on anticipated frame member or wall thicknesses. This increases attendant costs. This also causes window manufacturers and assemblers to stock and inventory multiple window stops depending upon anticipated frame member thicknesses, increasing attendant costs for the window manufacturer.

(*Id.* at 2-3.)

Thus, the claimed invention is drawn to a window stop that “is adapted to be mounted to a wall having a thickness between a range of thicknesses from a minimum thickness to a maximum thickness.” (*Id.* at 3.)

DISCUSSION

Claims 24, 30-33, 35, and 36 stand rejected under 35 U.S.C. § 103(a) over the combination of Bratcher and Kojima.

Bratcher is cited for disclosing a window stop comprising a housing defining a cavity that is capable of being mounted to a wall having a thickness between a minimum and maximum thickness (Ans. 3). Bratcher also teaches that a bolt is mounted inside the housing, the bolt being moveable between an extended and retracted position (*id.*). Bratcher is further cited for teaching the use of a biasing means, a cover defining a lip, and a resilient tab or extension member (*id.*). In the window stop of Bratcher, the engagement surface is parallel to the lip (*id.* at 4).

According to the Examiner, “Bratcher fails to disclose that the engagement surface is inclined with respect to the lip and that [sic] comprise at least one ridge or protrusion making the surface as a variable surface and where at least one ridge or protrusion is inclined away from the lip.” (*Id.* at 3-4.)

Kojima is cited as evidence that “it is well known in the art to provide a device that is going to be mounted into a frame with a resilient tab (40) having an inclined, planar and smooth engagement surface with respect to a lip (21) of a cover (20) that comprise at least one ridge or protrusion (41a-c) making the surface as a variable surface and where at least one ridge or protrusion (41c) that is inclined away from the lip so as to make the device

capable of being mounted to different thickness of the frame (Figures 7a-7c).” (Ans. 4)

The Examiner concludes:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the resilient tab described by Bratcher with an inclined engagement surface, as taught by Kojima, in order to secure the latch into the notch or opening on a wall or at a frame having any thickness.

(*Id.*)

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The Supreme Court has recently emphasized that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739. Moreover, an “[e]xpress suggestion to substitute one equivalent for another need not be present to render such substitution obvious.” *In re Fout*, 675 F.2d 297, 301 (CCPA 1982). We conclude that the Examiner has set forth a prima facie case of obviousness. We thus turn to Appellant’s arguments in rebuttal.

Appellant argues that there is no motivation to combine Bratcher with Kojima, and that the Examiner has engaged in improper hindsight in combining the references (App. Br. ¹ 12). Bratcher, Appellant asserts, provides no teaching or suggestion to modify the clips (34) to adapt to window frames having different thicknesses, and the fact that Kojima is a clip designed for automotive use, demonstrates the Examiner's use of improper hindsight (*id.* at 12-13).

Appellant also argues that “the features of the resin clip of Kojima would require significant modification to be incorporated into a window stop,” as the resin clip “is configured for insertion into a circular opening,” and “not an elongated opening, into which a window stop is typically inserted.” (App. Br. 14.) Moreover, Appellant argues, “the flange (20) of Kojima is inclined downward, in contrast to the lip of a window stop, which is typically parallel to the surface on which it rests.” (*Id.*)

Appellant argues further:

Additionally, all of the claims at issue recite that the engagement surface is inclined with respect to the lip, but Kojima does not discuss any advantages to such an arrangement. Kojima does disclose having a stepped configuration of the locking parts (41), and, in the embodiment shown in FIGS. 6-7C, the locking parts (41) appear to be angled downward. However, Kojima does not disclose even one advantage to configuring the locking parts (41) in any type of angled or inclined arrangement with respect to the flange (20). Thus, even if one skilled in the art would be motivated to look outside the relevant art to Kojima to develop a window stop for insertion into a frame of varying thickness, Kojima provides no

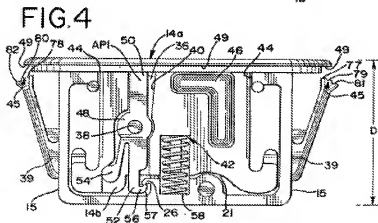
¹ All references to the Appeal Brief are to the Second Amended Appeal Brief dated June 25, 2007.

motivation or suggestion to utilize an engagement surface that is inclined with respect to the lip thereof.

(*Id.* at 14-15.)

Appellant additionally argues that Kojima is non-analogous art, and is thus not properly combinable with Bratcher (App. Br. 10). According to Appellant, the instant claims, as well as Bratcher, are drawn to a window stop for limiting movement of a sliding window, while Kojima is a resin clip designed to be fitted into an attachment hole in a panel for an automobile (*id.* at 11). Appellant thus argues that “[o]ne skilled in the art of windows and window stops could not be reasonably be expected to look to automobile panels and clips therefor to solve such a problem.” (*Id.*) Moreover, Appellant asserts, “the clip of Kojima is not designed, disclosed, or contemplated to operate with moving parts.” (*Id.*)

Appellant’s arguments are not found to be convincing. An embodiment of the window stop of the invention is shown in Fig. 4 below:

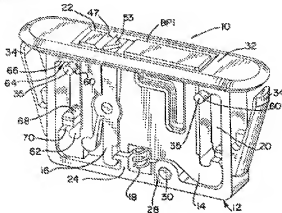


In the window stop shown, the engagement surface (45) comprises a first, second, and third ridge (78, 80, and 82), each of which is located successively further away from the lip (49) than its predecessor (Spec. 16, ll.

8-14). Confronting surfaces (77, 79, and 81) found among ridges (78, 80, and 82) allow the housing (12) to be installed in a wall (8) having a thickness between a minimum thickness and a maximum thickness (*id.* at ll. 14-21).

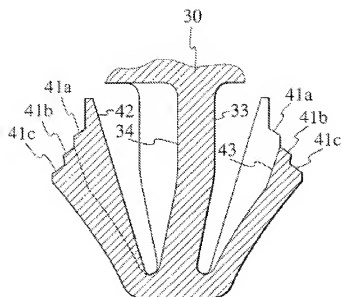
The window stop of Bratcher is shown in Fig. 3 below:

FIG. 3



In the window stop of Bratcher, a resilient clip (34) is used to retain the housing within the window frame, and extend from the exterior walls and upwardly toward the faceplate (32) (Bratcher, col. 4, ll. 7-14). The window stop of Bratcher is identical to the claimed window stop except that on clip of the claimed window stop there are a first, second, and third ridge (78, 80, and 82), each of which is located successively further away from the lip.

The Examiner relies on Kojima to make up that deficiency. The resin clip of Kojima is shown below:



The resin clip of Kojima is fitted into an attachment hole of a panel to “be put on an automobile or the like,” wherein the clip is designed to be “adaptable to a panel when a board thickness of the panel is varied within a certain range.” (Kojima, col. 1, ll. 6-12.) Specifically, Kojima teaches that “since the plurality of stepped locking parts **41a**, **41b** and **41c** are provided for engagement with the aperture edge of the attachment hole **51**, any one of the locking portions is adapted to the thickness and thereby engaged,” and thus the “same resin clip **10** can be adapted to a plurality of panels **50** with various thicknesses.” (*Id.* at col. 5, l. 54-col. 6, l. 2.)

Thus, we conclude that it would have been obvious to one of ordinary skill in the art to use the stepped locking parts of Kojima in the resilient resin clip of the window stop of Bratcher to allow the window stop to be used in wall of different thickness. We acknowledge that Kojima was written in the context of the automotive art, while Bratcher is drawn to a window stop. But, as noted by the Supreme Court:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and one of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

KSR, 127 S. Ct. at 1740.

Kojima teaches that stepped locking parts allow a clip to be used to secure the clip to a panel with a variety of thicknesses, and as noted by the Specification, window stop manufacturers needed to produce multiple housings based on anticipated frame member or wall thicknesses, which increased cost (Spec. 2-3). Thus, there were recognized market forces for a window stop that could be used walls of differing thicknesses. Moreover, there is no evidence on record that it would have been beyond the level of skill of the ordinary artisan to add the stepped locking ridges to the resilient clip of the window stop of Bratcher to allow the window stop to be used in walls of differing thicknesses.

Although Kojima does not specifically disclose an advantage to configuring the locking parts (41) in any type of angled or inclined

arrangement with respect to the flange (20), we find that it would have well within the level of skill of the ordinary artisan to determine the best arrangement to obtain the best result to secure the stop to the wall. Moreover, the fact that the clip of Kojima is configured for insertion into a circular opening does not claim 24 unobvious, as Kojima specifically teaches that it is the stepped locking edges that allow for attachment to panels of differing thicknesses.

Finally, in response to Appellants argument that the clip of Kojima would need significant modification to combine it with the window stop of Bratcher, as noted by the Examiner (Ans. 6), the window stop structure is well known in the art, as demonstrated by Bratcher. The only modification that is needed is the addition of stepped locking edges, which are taught by Kojima, and are also taught by Kojima to allow for attachment of the same clip to panels or walls of differing thicknesses.

We therefore affirm the rejection as to claim 24. As Appellant does not argue claims 30-33 and 36 separately (App. Br. 10), the rejection is affirmed as to those claims as well.

As to claim 35, Appellant argues that claim 35 requires “a tab . . . having a planar engagement surface distal from the base portion, the planar engagement surface being spaced from the lip and inclined with respect to the lip, the planar engagement surface extending from an inner edge of the tab proximal to the housing to an outer edge of the tab distal from the housing.” (App. Br. 15) According to Appellant, “Kojima does not disclose a tab having a planar engagement surface ‘extending from an inner edge of the tab proximal to the housing to an outer edge of the tab distal from the

housing.” (*Id.* at 16.) Rather, Appellant asserts, “the resin clip (10) of Kojima has a stepped engagement surface containing several stepped locking parts (41), rather than a single engagement surface that extends from an inner edge to an outer edge of the tab.” (*Id.*)

Appellant’s argument is not convincing. Claim 35 is drawn to a window stop *comprising* “a tab . . . , the tab having a planar engagement surface distal from the base portion, the planar engagement surface being spaced from the lip and inclined with respect to the lip, the planar engagement surface extending from an inner edge of the tab proximal to the housing to an outer edge of the tab distal from the housing.” Claim 35 uses the transition phrase “comprising,” and thus does not exclude additional planar engagement surfaces. Thus, there is nothing in claim 35 that requires a single engagement surface, and the rejection is affirmed.

CONCLUSION

As the Examiner has set forth a *prima facie* case that claims 24, 30-33, 35, and 36 are obvious over the combination of Bratcher and Kojima, which has not been rebutted by Appellant, the rejection is affirmed.

Appeal 2008-3524
Application 10/752,406

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Ssc:

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